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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,573	08/01/2001	Cary Lee Bates	ROC920010153US1-IBM	3523
7590	05/24/2005		211	
Robert H. Berdo, Jr. RABIN & BERDO, P.C. Suite 500 1101 14th Street, N.W. Washington, DC 20005			EXAMINER	
			MITCHELL, JASON D	
			ART UNIT	PAPER NUMBER
			2193	
DATE MAILED: 05/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/918,573	Applicant(s) BATES ET AL.	
	Examiner Jason Mitchell	Art Unit 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 0121.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-15 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                               |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                              | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/15/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

This action is in response to the response filed on 12/2/04

As per Applicant's request, claim 11 has been amended, and no claims are canceled.

Claims 1-15 are pending in this application.

### ***Response to Arguments***

Applicant's arguments, see pg. 9, par 1 and 3, filed 12/2/05, with respect to the 102(b) rejection of claims 1-15 over Wahbe have been fully considered and are persuasive.

The 102(b) rejection of claims 1-15 has been withdrawn.

### ***Claim Objections***

Applicant's arguments/amendments were sufficient to overcome the objection to claims 1-5 and 11-15. Consequently the objection has been withdrawn.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-5 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** Claim 1 recites a program debugger, with means for extracting and removing induction rates and IV-breakpoints but does not tie the claim to a tangible media. Therefore the claim is directed to software, per se, and is

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consequently rejected as not being tangible. Claims 2-5 which depend from claim 1 do not fix this deficiency.

***Allowable Subject Matter***

2. Claims 6-15 are allowed.

***Examiner's Statement of Reasons for Allowance***

3. The following is a statement of reasons for the indication of allowable subject matter:

4. The cited prior art taken alone or in combination fail to teach, in combination with the other claimed limitations, 'extracting, from program code within the loop, the induction rate; extracting, from the IV-breakpoint, a final value for which the IV-breakpoint may be satisfied; and removing the IV-breakpoint, if the IV-breakpoint is satisfied and the induction variable has a present value that would be beyond the final value upon a next iteration of the loop based on the induction rate' as recited in independent claims 1, 6 and 11.

5. The closest prior art, Wahbe, teaches 'extracting, from program code within the loop, the induction rate; extracting, and from the IV-breakpoint, a final value for which the IV-Breakpoint may be satisfied, but fails to teach 'removing the IV-breakpoint, if the IV-breakpoint is satisfied and the induction variable has a present value that would be beyond the final value upon a next iteration of the loop based on the induction rate' as argued by Applicant on pg. 9 of the response filed 12/2/05.

***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Mitchell  
5/16/05



**ANIL KHATRI**  
**PRIMARY EXAMINER**